

Exhibit B

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MASAMITSU YAMAMOTO et al.

Appeal No. 2000-0286  
Application No. 08/704,031

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8 to 12, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

<sup>1</sup> Claim 8 was amended subsequent to the final rejection.

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Application No. 08/704,031

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BACKGROUND

The appellants' invention relates to a disposable absorbent undergarment. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Watanabe et al. 1992 (Watanabe)	GB 2 253 131 A	Sep. 2,
Tagawa et al. (Tagawa)	EP 0 623 331 A2	Nov. 9, 1994

Claims 8 to 12 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

Claims 8 to 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Watanabe in view of Tagawa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 12, mailed April 23, 1998) and the answer (Paper No. 24, mailed April 9, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 23, filed February 23, 1999) and reply brief (Paper No. 25, filed June 9, 1999) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The written description rejection**

We will not sustain the rejection of claims 8 to 12 under 35 U.S.C. § 112, first paragraph.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039,

34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

The examiner determined (final rejection, p. 3) that claims 8 to 12 violated the written description requirement of the first paragraph of 35 U.S.C. § 112 due to the inconsistency of the description of the second elastic material (e.g., the claimed second elastic material referencing elastically stretchable members 15 while the specification referred to the second elastically stretchable members by reference number 14). The appellants admit (brief, p. 5) that there is an inconsistency between the terminology used in the claims under appeal and the specification and state that they are willing to file an amendment to make the claims consistent with the specification.<sup>2</sup> The appellants then go on to argue that notwithstanding the inconsistencies, the claims under appeal are described in the original specification in a way as to reasonably convey to one skilled

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<sup>2</sup> Notwithstanding our reversal of this ground of rejection, we encourage the appellants to file such an amendment.

in the art that the inventors had possession of the now claimed invention.

In our view, the appellants' original disclosure does provide, with reasonable clarity, written description support for the claimed subject matter found objectionable by the examiner as set forth above. In that regard, the claims under appeal clearly recite first elastic material, second elastic material and third elastic material which one skilled in the art would reasonably know refer respectively back to the first elastically stretchable members 13, the elastically stretchable members 15 and the second elastically stretchable members 14. Accordingly, the decision of the examiner to reject claims 8 to 12 under 35 U.S.C. § 112, first paragraph, is reversed.

**New ground of rejection**

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against appellants' claims 8 to 12:

Claims 8 to 12 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention. The original disclosure (p. 10) provided that the liquid-absorbent pad included a **liquid-permeable topsheet 38**, a liquid-impermeable backsheet 39 and a liquid-absorbent panel disposed therebetween. Original claim 1 provided that the liquid-absorbent pad comprises a **liquid-permeable topsheet**, a backsheet and a liquid-absorbent panel disposed between these two sheets. Claim 8 (first presented in the amendment filed on June 13, 1997, Paper No. 7) recites that the liquid-absorbent pad comprises a **liquid-impermeable topsheet**, a backsheet and a liquid-absorbent panel disposed therebetween. After reviewing the original disclosure, we fail to find any written description support for the topsheet of the liquid-absorbent pad being **liquid-impermeable**.

**The obviousness rejection**



We will not sustain the rejection of claims 8 to 12 under 35 U.S.C. § 103.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Thus, even a claim limitation which lacks written description support cannot be disregarded.

In this case, the inner sheet 15 of Watanabe's absorbent body 3 (which corresponds to the claimed topsheet of the liquid-absorbent pad) is liquid permeable not liquid impermeable as claimed. Since the applied prior art would not have suggested making the inner sheet 15 of Watanabe's absorbent body 3 impermeable, we must reverse the decision of the examiner to reject claims 8 to 12 under 35 U.S.C. § 103.

Since in response to our new ground of rejection made above the appellants may amend claim 8 by changing "liquid-impermeable topsheet" to "liquid-permeable topsheet," we present our views on three issues of obviousness raised in the appeal to expedite any further prosecution of the claimed subject matter. First, it is our opinion that the claimed "said crotch section including a liquid-impermeable film stretchable at least in said longitudinal direction" would have been obvious at the time the invention was made to a person having ordinary skill in the art from the teachings of the applied prior art since Tagawa's teachings of a film in backsheet 3 (column 8, lines 21-28) would have been suggestive to modify Watanabe's outermost impermeable layer 2 to include a stretchable liquid-impermeable film. Second, it is our opinion that the claimed "said crotch section further including second elastic material extending between said pair of leg-openings so as to be stretchable transversely of said short pants, a portion of said second elastic material extending along rear side peripheries of said leg-openings and another portion of said second elastic material extending across said crotch section in proximity of said lower ends of

said leg-openings" would have been obvious at the time the invention was made to a person having ordinary skill in the art from the teachings of the applied prior art since Tagawa's teachings using either elastically expansible members 8 (see Figures 1-5) or elastically expansible members 115a and 115b (see Figures 6-10) would have been suggestive to modify Watanabe's elastic members 13 to be shaped as suggested by the elastically expansible members 115a and 115b of Tagawa.

Third, with respect to claim 9, it is our view that a prima facie case of obviousness has not been established since the examiner has not presenting any evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. In that regard, the mere fact that a difference (between the teachings of the prior art and the claimed subject matter) does not provide any new result or solve any recognized problem does not, *ipso facto*, make that difference obvious under 35 U.S.C. § 103. Thus, we view the examiner's reliance (answer, p. 7) on In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) to be misplaced in this instance.

CONCLUSION

To summarize, the decision of the examiner to reject claims 8 to 12 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 8 to 12 under 35 U.S.C. § 103 is reversed; and a new rejection of claims 8 to 12 under 35 U.S.C. § 112, first paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

ground of rejection to avoid termination of proceedings

(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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Exhibit C

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MASAMITSU YAMAMOTO, TAKAMITSU IGAUE,  
YOSHIHISA FUJIOKA and HIROTOMO MUKAI

Appeal No. 2000-0301  
Application No. 08/690,402

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 7, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a disposable diaper (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lawson 1987	4,695,278	Sep. 22,
Enloe 1987	4,704,116	Nov. 3,
Foreman 1988	4,738,677	Apr. 19,
Igaue et al. 1990 (Igaue)	4,904,251	Feb. 27,
Robertson 25, 1991	5,026,364	June
Kido Apr. 20, 1994	GB 2,271,501	

Claims 1 to 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kido in view of Enloe, Lawson, Foreman, Igaue and Robertson.

Claims 1 and 4 to 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Enloe in view of Lawson, Foreman, Igaue and Robertson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 30, mailed April 14, 1999) for the examiner's complete reasoning in support of the rejections, and to the substitute appeal brief (Paper No. 29, filed January 4, 1999) and reply brief (Paper No. 31, filed June 14, 1999) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness

with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 7 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence<sup>1</sup> that would

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<sup>1</sup> Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See also (continued...)

have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue that the applied prior art does not suggest the claimed subject matter. Specifically, the appellants assert (brief, pp. 4-13) that the "pair of elasticized cuffs" as set forth in the independent claims on appeal (i.e., claims 1 and 6) are not suggested by the applied prior art absent the use of impermissible hindsight.<sup>2</sup> More specifically, the appellants argue that the applied prior art does not teach or suggest the claimed pair of elasticized cuffs including "a substantially crescent-shape portion" or "a

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<sup>1</sup>(...continued)  
In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

<sup>2</sup> The use of hindsight knowledge derived from the appellants' own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

crescent-shape portion" as recited in the claims under appeal.

All the claims under appeal require the claimed pair of elasticized cuffs to include either "a substantially crescent-shape portion" as recited in claim 1 or "a crescent-shape portion" as recited in claim 6. However, it is our opinion that these limitations are not taught or suggested by the combined teaching of the applied prior art.

To supply this omission in the teachings of the applied prior art, the examiner made determinations (answer, pp. 4-10) that this difference does not provide any new result or solve any recognized problem in the art and that the cuffs of Kido are "substantially crescent-shaped."

In proceedings before the United States Patent and Trademark Office (USPTO), the USPTO applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever

enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). When this is done, we conclude that the term "crescent-shape" as used in the claims under appeal means a shape having concave and convex edges terminating in points.<sup>3</sup>

Clearly, the cuffs of Kido are not "substantially crescent-shaped" or "crescent-shaped" since they are shown to be "segment-shaped."<sup>4</sup> Moreover, none of the cuffs of Enloe, Lawson, Foreman, Igaue or Robertson are "substantially crescent-shaped" or "crescent-shaped." Thus, the applied prior art does not teach or suggest the claimed "substantially crescent-shaped" cuffs or "crescent-shaped" cuffs.

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<sup>3</sup> In reaching this conclusion we have utilized the definition of "crescent" provided on page 5 of the brief as well as the appellants use of that term in describing cuffs 10 and 10A (see Figure 1 and pages 7-9 of the specification).

<sup>4</sup> A segment is the area bounded by a chord and the arc of a curve subtended by the chord.

As set forth above, a prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. The mere fact that a difference (between the teachings of the prior art and the claimed subject matter) does not provide any new result or solve any recognized problem does not, *ipso facto*, make that difference obvious under 35 U.S.C. § 103. Thus, we view the examiner's reliance (answer, p. 7) on In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) to be misplaced in this instance.

In our view, the only possible suggestion for modifying the applied prior art in the manner proposed by the examiner to meet the "cuff" limitations of the claims under appeal stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. It follows that we cannot sustain the examiner's rejections of claims 1 to 7.



CONCLUSION

To summarize, the decision of the examiner to reject  
claims 1 to 7 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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